

Application No. 10/021,482
Response to OA of 12/15/2005

Remarks

In the present response, three claims (31, 35, 82) are amended; one claim (86) is canceled; and one claim (93) is newly added. Claims 31-36, 82-85, and 87-93 are presented for examination.

I. Incomplete Office Action

The Office Action mailed December 15, 2005 never rejected claims 89-92 which were presented in the RCE dated February 22, 2005. These claims are not subject to a restriction and are clearly within the elected subject matter.

Applicants respectfully ask the Examiner to either allow claims 89-92 or issue a non-final Office Action so Applicants have an opportunity to address any rejection to these claims.

II. Claim Rejections: 35 USC § 103

Claims 31-36 and 82-88 are rejected under 35 USC § 103 as being unpatentable over Ito et al. (USPN 6,302,795, hereinafter Ito) in view of Bloomfield et al. (US# 2002/0028704 A1, hereinafter Bloomfield). This rejection is traversed.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Applicants assert that the rejection does not satisfy these criteria.

No Suggestion/Motivation to Modify/Combine References

For at least the following reasons, no suggestion or motivation exists to modify or combine Ito in view of Bloomfield.

First, Applicants argue that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions. Ito is directed to a video game machine as a home console and a portable terminal machine that

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downloads programs from the video game machine (4: 47-55). The portable terminal machine is removable from the video game machine and downloads gaming programs from the video game machine (6: 64-67). In short, Ito is directed to a video game machine having a portable terminal portion. By contrast, Bloomfield is directed to a portable device that a user wears to collect environmental data about the user's whereabouts ([0005]). The portable device includes environmental sensors for capturing environmental data, such as humidity, barometric pressure, and outdoor temperature ([0036]). The captured environmental data is compared with stored environmental data to determine a location of the user ([0018]).

The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Such teaching or suggestion does not exist.

Second, Applicant argues that no teaching or suggestion exists to make the combination because the references are directed to solving completely different problems. In Ito, the Background section discusses the problem that video game users illegally download and use video games (1: 27-42). In fact, Ito explicitly states that the object of his invention is to solve the problem of illegally downloading shareware (1: 43-50). By contrast, Bloomfield solves a completely different problem. In Bloomfield, the Background section discusses the problems that agents can only collect data about a user's activities when the user is using a computer ([0003]). This data is used to track user preferences, habits, and interests so personal services or advertisements can be sent to the user ([0002]). Bloomfield explicitly states that the object of his invention is to solve the problems previously associated with only gathering information about a user when he or she was on a computer. ([004-005]).

To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have

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been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). In light of the completely different inventions and problems being solved in Ito and Bloomfield, no suggestion or motivation exists to combine or modify these references.

For at least these reasons, Applicants respectfully ask the Examiner to withdraw the rejection since a *prima facie* case of obvious has not been established.

All Elements Not Taught or Suggested

All of the elements of the claims are not taught or suggested in Ito and Bloomfield. In other words, evening assuming *arguendo* that Ito and Bloomfield are successfully combinable (which they are not), the alleged combination does not teach or suggest all the elements in the claims.

Each of the independent claims recites recitations regarding capturing medical data of the user or sensing biometric events of the user. For instance, claim 31 is amended to recite "capturing medical data of the user." Independent claim 82 is amended to recite "wherein the data collection devices include a biometric sensor that gathers medical data of the user." Further, claim 89 recites a biometric unit for "sensing plural different biometric events of the user." Nowhere do Ito and Bloomfield teach or suggest such recitations. Bloomfield does teach a portable device that captures environmental data, such as humidity, barometric pressure, and temperature. Bloomfield never suggests that this environmental data includes capturing medical data of the user or sensing biometric events of the user.

If the Examiner continues to reject the claims under Ito and Bloomfield, then Applicants respectfully ask the Examiner to cite a location in either Ito or Bloomfield that teaches or suggests capturing medical data of the user or sensing biometric events of the user.

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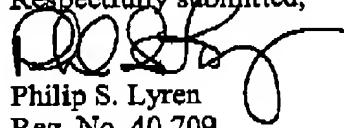
CONCLUSION

In view of the above, Applicants believe all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

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CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 7th day of March, 2006.

By

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